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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,160	06/13/2001	Shigehisa Tonomura	1341.1095	3652
21171	7590	10/02/2007	EXAMINER	
STAAS & HALSEY LLP			KE, PENG	
SUITE 700			ART UNIT	
1201 NEW YORK AVENUE, N.W.			PAPER NUMBER	
WASHINGTON, DC 20005			2174	
			MAIL DATE	DELIVERY MODE
			10/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/879,160

Applicant(s)

TONOMURA, SHIGEHISA

Examiner

Peng Ke

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to communications: Amendment, filed on 7/16/07.

Claims 1-5, 9, and 11 are pending in this application. Claims 1, 9, and 11 are independent claims. In amendment filed on 7/16/07, claims 1, 9, and 11 were amended and claims 6-8, 10, and 12-19 were cancelled.

### ***Claim Rejections – 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 5, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashizaki, U.S. Patent No. 6,829,430 in view of Yoon et al., U.S. Patent No. 6,173,407.

As per claim 1, Ashizaki teaches an information providing method comprising the steps of: accepting photographed data including photographing position information from a user (see Ashizaki, column 17, lines 63-column 18, lines 20);

acquiring a content to be inserted into the photographed data wherein said content corresponds to the photographing position information and is acquired from a position-distinction contents database based on the photographing position information in the accepted photographed data, wherein said position-distinction contents database stores photographing

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position information and the content in a correlated manner (see Ashizaki, column 19, lines 16-35); and

inserting and editing the acquired content into a portion of the photographed data corresponding to the photographing position information (see Ashizaki, column 10, lines 40 – 64), wherein the content includes image data or sound data symbolizing an area which corresponds to the photographing position information (see Ashizaki, column 21, lines 40-65; column 17, lines 63-column 18, lines 20).

However, Ashizaki fails to include fee information that corresponds to the data, said fee information being provided according to inserted and edited files.

Yoon teaches content that includes fee information that corresponds to the data, (see Yoon, column 7, lines 9 – 50), said fee information being provided according to inserted and edited files. (see Yoon column 1, lines 40-45; Charges is the same as fee)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Yoon with the method of Ashizaki in order to generate revenue for the content provider.

As per claim 2, which is dependent on claim 1, Ashizaki and Yoon teach the method of claim 1 (see rejection above). Yoon et al. (“Yoon”) further teaches teaches an information providing method comprising the step of calculating an appropriate fee for providing content (see Yoon, column 7, lines 9 – 50).

As per claim 3, which is dependent on claim 1, Ashizaki and Yoon teach the method of claim 1 (see rejection above). Ashizaki further teaches the information providing method

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according to claim 1, wherein the accepting step further includes the steps of, accepting information for specifying the user along with the photographed data including the photographing position information (see Ashizaki, column 17, lines 63-column 18, lines 20); and transmitting the inserted and edited photographed data to the user based on the accepted information for specifying the user (see Ashizaki, column 10, lines 40 – 64).

As per claim 4, which is dependent on claim 1, Ashizaki and Yoon teach the method of claim 1 (see rejection above). Ashizaki further teaches the information providing method according to claim 1, wherein the photographed data are data photographed in a certain bigger area, and the photographing position information is information about a smaller area in the bigger area where the photographing is executed or information showing a photographing spot (see Ashizaki, figure 4, items 18, and 28).

As per claim 5, which is dependent on claim 1, Ashizaki and Yoon teach the method of claim 1 (see rejection above). Ashizaki further teaches the information providing method according to claim 1, wherein the photographed data are frames of original dynamic images (see Ashizaki, column 13, lines 43 – 56; the examiner interprets images captured by a digital video recorder as frames of original dynamic images).

As per claims 9 and 11 they are of similar scope to claim 1 and are rejected under the same rationale as claim 1 (see rejection above),

***Response to Argument***

Applicant's arguments filed on 7/16/07 have been fully considered but they are not persuasive.

Applicant's argument focused on the following:

Ashizaki fails to teach the content includes image data or sound data symbolizing an area of the photographing position information.

The examiner does not agree for the following reasons:

During patent examination, the pending claims must be "given >their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

In this case, Ashizaki teach this limitation because Ashizaki teaches a data medium that corresponds to the video data, which are image data, and audio signals with the position data of

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the medium in a form of auxiliary data or sub-code data on a recording track. (column 21, lines 40-65)

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peng Ke whose telephone number is (571) 272-4062. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peng Ke

*Kristine Kincaid*  
KRISTINE KINCAID  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100



# Index of Claims



Application/Control No.

09/879,160

Examiner

Peng Ke

Applicant(s)/Patent under Reexamination

TONOMURA, SHIGEHISA

Art Unit

2174

✓	Rejected
=	Allowed

—	(Through numeral) Cancelled
+	Restricted

N	Non-Elected
I	Interference

A	Appeal
O	Objected

Claim	Date
Final	Original
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